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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,312	01/26/2001	Aya Jakobovits	511582000100	7650

36327 7590 02/12/2007  
AGENSYS C/O MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER
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FETTEROLF, BRANDON J

ART UNIT	PAPER NUMBER
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1642

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/771,312	<b>Applicant(s)</b> JAKOBOVITS ET AL.	
	<b>Examiner</b> Brandon J. Fetterolf, PhD	<b>Art Unit</b> 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12, 14, 15 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 14, 15 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/03/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/03/2006 has been entered.

Claims 12, 14-15 and 39 are currently pending and under consideration.

### *Information Disclosure Statement*

The Information Disclosure Statement filed on 11/03/2006 acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. A signed copy of the IDS is attached hereto.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, 14-15 and 39 are/remain rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Claims 12, 14-15 and 39 are directed to an isolated recombinant protein comprising the amino acid sequence of SEQ ID NO: 2, wherein the recombinant protein is encoded by a nucleotide sequence of SEQ ID NO: 1. However, neither the specification nor any art of record teaches what the amino acid sequence of SEQ ID NO: 2 is, how it functions, or a specific and well-established utility as claimed. The specification asserts (page 15, lines 28-29 and page 16, lines 1-18) that the polypeptides of the invention can be utilized to generate antibodies for use in detecting 84P2A9 overexpression or the metastasis of prostate cells and/or cells of other cancers expressing

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the gene. Thus, it is presumed that there is a correlation between the overexpression of the polypeptide and a particular disease state. Furthermore, the specification teaches (page 18, lines 15-17) that the proteins of the invention may also be used in the forensic analysis of tissues of unknown origin.

The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-tumor activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are “useful” to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of “useful” as it appears in 35 U.S.C. §101, which requires that an invention must have either an immediately apparent or fully disclosed “real world” utility. The court held that:

The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. . . . [u]nless and until a process is refined and developed to this point-where *specific* benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field. . . . a patent is not a hunting license. . . . [i]t is not a reward for the search, but compensation for its successful conclusion.

Although the specification discloses a nexus between the polynucleotide expression and a disease state (see for example page 75, Example 3), the specification does not disclose a correlation between any specific disorder and an altered level or form of the claimed polypeptide. If a molecule such as the polypeptide of SEQ ID NO: 2 is to be used as a surrogate for a disease state, some disease state must be identified in some way with the molecule. There must be some expression pattern that would allow the claimed polypeptide to be used in a diagnostic manner. Many polypeptides may be expressed in normal tissues, as well as diseased tissues. Therefore, one needs to know, e.g., that the claimed polypeptide is present only in cancer tissue to the exclusion of normal tissue. Thus, in the absence of any correlation between the claimed polypeptide with any known disease or disorder, any information obtained from various expression profiles in both normal and diseased tissue only serves as the basis for further research on the observation itself.

Furthermore, those of skill in the art recognize that over expression of a particular nucleic acid specific for a tissue type, does not necessarily correlate nor predict equivalent levels of polypeptide expression. There are many steps in the pathway leading from DNA to protein, and all of them can, in principle, be regulated. For example, Alberts *et al.* (Molecular Biology of the Cell, 3<sup>rd</sup> edition, 1994, page 465, *of record*) illustrate post-transcriptional regulation of ferritin wherein the translation of ferritin mRNA into ferritin polypeptide is blocked during periods of iron starvation. Likewise, if excess iron is available, the transferrin receptor mRNA is degraded and no transferrin receptor polypeptide is translated. Lewin, B. also teaches (Genes VI, Oxford University Press, Inc., NY, Chapter 29, 1997, *of record*) that a major control point for genes exists during the initiation of transcription by the interaction of the RNA polymerase with its promoter. Concurring with Alberts *et al.*, Lewin further acknowledges downstream control of gene expression since translation of mRNA in the cytoplasm is also a point of control. Also, with regards to tumor associated antigens, Fu et al (EMBO Journal, 1996, Vol. 15, pp. 4392-4401, *of record*) teach that levels of p53 protein expression do not correlate with levels of p53 mRNA levels in blast cells taken from patients with acute myelogenous leukemia, said patients being without mutations in the p53 gene. Furthermore, Mallampalli *et al.* (Biochem. J. Vol. 318, 1996, pages 333-341, *of record*) teach that the glucocorticoid, betamethasone, increased mRNA expression of cholinephosphate cytidylyltransferase (CT) as determined by RT-PCR and Southern analysis, but did not alter the levels of the CT enzyme as assayed by Western blotting (abstract, and page 339, 2<sup>nd</sup> column, 2<sup>nd</sup> paragraph). Finally, Lewin acknowledges that control of gene expression can occur at multiple stages and that production of RNA *cannot inevitably* be equated with production of protein. Thus, the predictability of protein translation and its possible utility as a diagnostic are not necessarily contingent on the levels of mRNA expression due to the multitude of homeostatic factors affecting transcription and translation. Therefore, absent evidence of the polypeptide expression including the correlation to a particular diseased state, for example present and/or absent as compared to control, one of skill in the art would not be able to predictably use the invention in a way that constitutes a specific and substantial utility and as disclosed do not meet the requirements of 35 U.S.C. §101 as being useful.

Claims 12, 14-15 and 39 also are/remain rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well

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established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Therefore, No claim is allowed.

### ***Conclusion***

This is a continuation of applicant's earlier Application No. 09/771,312. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Fetterolf, PhD whose telephone number is (571)-272-2919. The examiner can normally be reached on Monday through Friday from 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon J Fetterolf, PhD  
Patent Examiner  
Art Unit 1642

BF

  
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